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EXAMINER

SALCE, JASON P

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/034,939

Applicant(s)

KNUDSON ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-183 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-102, 105-108, 111-114, 117-120, 123-175 and 178-181 is/are rejected.
- 7) ☒ Claim(s) 103, 104, 109, 110, 115, 116, 121, 122, 176 and 177 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 2/28/00 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:  
  
58. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. Claim 9, 15, 54, 60, 131 and 137 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what a "set reminders screen" means. For the remainder of this office action the examiner will interpret this limitation to mean "a reminders screen".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application

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being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-19, 21-35, 37-41, 46-64, 66-80, 82-86, 91-98, 123-141, 143-157, 159-163, and 168-171 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schein et al. (U.S. Patent No. 6,388,714).

Referring to claim 1, Schein discloses a system in which an interactive television program guide is implemented on user television equipment (see Figure 1 and Column 4, Lines 11-15). Schein also discloses a means for monitoring a user's interactions with the interactive television program guide to determine the user's interests (see "search engine at Column 15, Lines 31-52, "hot pick" at Column 15, Lines 53-63, "virtual agent" at Column 16, Lines 2-7, and "respond to a survey" at Column 16, Line 53 for monitoring a user's interactions and determining user interests to provide a program guide). Schein also discloses a means for presenting targeted advertising to the user with the interactive television program guide based on the user's interests (see "the viewer watches a sports event such as a football game" at Column 16, Lines 40-41, and that the television network broadcasting the football game can "provide an icon that allows the user to access a database providing more information about the football game" at Column 17, Lines 1-4, also note Column 20, Lines 16-44).

Referring to claim 2, Schein discloses that the targeted advertisement contains text (see test advertisement in Figure 17C).

Referring to claim 3, Schein discloses that the targeted advertisement contains graphics (see graphic of NFL cap in Figure 17C).

Referring to claim 4, Schein discloses that the targeted advertisement contains video (see the football game still broadcasting in a PIP view in Figure 17C).

Referring to claim 5, Schein discloses that the system contains a set-top box (see Figure 7).

Referring to claim 6, Schein discloses a television distribution facility for distributing television programming (see Figures 9-10 and Column 13, Lines 46-48 and Column 14, Lines 18-20), and a video server located in the television distribution facility for providing targeted advertisements (see Figures 10 and 11 and Column 14, Lines 18-20 and Column 16, Lines 9-15).

Referring to claim 7, Schein discloses a television distribution facility in claim 6, as well as a video server (see Figure 10 for a plurality of servers, and note that Schein makes it clear that the system can contain one or more servers at Column 14, Lines 18-20 and Lines 32-35). Schein also discloses a plurality of network nodes for providing television programming and that servers are located at some of the network nodes (again see Figure 10 and Column 14, Lines 18-20 and Lines 32-35).

Referring to claim 8, Schein discloses displaying a browse display region that contains a targeted advertisement (see Figure 17C for purchasing an NFL cap).

Referring to claim 9, Schein discloses displaying a set reminders screen that contains a targeted advertisement (see configuring the program guide by placing a reminder to watch the program at Column 12, Lines 26-34).

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Referring to claim 10, see rejection of claim 9.

Referring to claim 11, Schein discloses displaying a by time screen that contains a targeted advertisement (see Column 17, Lines 45-50 for scrolling vertically through a program guide according to the time a program is broadcast).

Referring to claim 12, Schein discloses displaying a select start-time pay-per-view purchasing screen that contains a targeted advertisement (see Figure 14C for purchasing a pay-per-view movie "Legends of the Fall" at 7:55pm, and option (1) for viewing more information (targeted advertisement) of the movie).

Referring to claim 13, Schein discloses displaying an order review screen that contains a targeted advertisement (see Figure 14D).

Referring to claim 14, Schein discloses displaying a targeted pay-per-view ordering screen that contains a targeted advertisement (see rejection of claim 12, and Figures 14B and 14C).

Referring to claim 15, Schein discloses displaying a targeted reminders screen that contains a targeted advertisement (see rejection of claim 9).

Referring to claim 16, Schein discloses displaying a navigator screen that contains a targeted advertisement (see HBO navigation screen, and targeted advertisement window 728 or 524 in Figure 12B).

Referring to claim 17, Schein discloses displaying a by channel program listings screen that contains program listings for a particular channel and that contains a targeted advertisement (see rejections of claim 16).

Referring to claim 18, Schein discloses displaying a program promotion screen that contains a targeted advertisement (see option (6) for a promotional family ticket offer and option (1) for a targeted advertisement which contains more information on the options (2) through (6) in Figure 14B).

Referring to claim 19, Schein discloses displaying a pay-per-view program information screen that contains a targeted advertisement (see option (1) in Figures 14A to 14E and Column 18, Lines 56-61 for how option (1) can be selected in a football game environment to provide more targeted information).

Referring to claim 21, see rejection of claim 9.

Referring to claim 22, Schein discloses determining whether the user has taken steps toward purchasing a program (see steps of ordering a program and confirmation screen in Figures 14A-E).

Referring to claim 23, Schein discloses determining whether the user has purchased a program (see confirmation screen in Figure 14E and Column 19, Lines 26-28).

Referring to claim 24, Schein discloses determining whether the user has taken steps toward recording a program (see option (3) in Figure 14A and Column 6, Lines 42-45).

Referring to claim 25, Schein discloses determining whether the user has selected certain categories of programs of interest (Column 5, Lines 60-63)

Referring to claim 26, Schein discloses determining whether the user has viewed information on programs that are scheduled to be broadcast at a particular time (see

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memory containing start and end times and channel at Column 6, Lines 65-67 and Column 7, Lines 1-3, and also note Column 7, Lines 31-40).

Referring to claim 27, Schein discloses determining whether the user has viewed information on programs scheduled to be broadcast on a particular channel (see rejection of claim 26, which includes channel information being stored and Column 18, Lines 59-63).

Referring to claim 28, Schein discloses determining whether the user has defined user preferences in the program guide that are indicative of the user's interests (Column 12, Lines 38-47).

Referring to claim 29, Schein discloses a flip display region that contains a targeted advertisement (see element 524 in Figure 12B and Column 18, Lines 22-25).

Referring to claim 30, see rejection of claim 9.

Referring to claim 31, Schein discloses a movie-listing screen that contains a targeted advertisement (see element 726 or 524 in Figure 12B).

Referring to claim 32, Schein discloses a program information screen that contains a video advertisement (see element 726 of Figure 12B and Column 18, Lines 12-17, also see rejection of claim 31).

Referring to claim 33, see rejection of claim 31.

Referring to claim 34, Schein discloses a pay-per-view movie listings screen that contains a targeted advertisement (see Figure 14B).

Referring to claim 35, Schein discloses displaying a targeted advertisement over a currently displayed television program (see element 730 in Figure 13B).



Referring to claim 37, Schein discloses displaying a targeted advertisement that is an active object (see element 724 in Figure 12A and Column 18, Lines 25-27 to show that the commercial message (targeted advertisement) is an active object).

Referring to claim 38, Schein discloses displaying a targeted advertisement to the user that contains targeted product information (see Figures 17A through 17F to see the process of purchasing an NFL cap related to a football game broadcast, also note Column 20, Lines 16-44 for the description of these figures).

Referring to claim 39, Schein discloses displaying a targeted advertisement to the user that contains targeted product information and an associated purchase option (see again Figures 17A through 17F and Column 20, Lines 16-44).

Referring to claim 40, Schein discloses displaying a targeted advertisement to the user that contains targeted product information and an associated additional information options (see option (1) in Figure 17C).

Referring to claim 41, Schein discloses displaying a relatively small targeted advertisement (see "Linked Service" in Figure 17B or program guide element 710 in Figure 17A). Schein also discloses allowing the user to select the relatively small targeted advertisement (Column 20, Lines 20-25). Schein also discloses displaying a corresponding substantially full-screen targeted advertisement containing video to the user when the user selects the displayed relatively small targeted advertisement (see Figure 17C and Column 25-39).

Referring to claims 46-64, 66-80, and 82-86, see rejection of claims 1-19, 21-35, and 37-41, respectively.

Referring to claim 91, see rejection of claim 1. Also note that the only difference between claim 1 and claim 91 is the term “targeted action”, which is broader than “targeted advertising”, therefore the rejection of claim 1 covers all the limitations in claim 91.

Referring to claim 92, Schein discloses automatically setting a program reminder based on the user’s interests (see Column 12, Lines 24-38). Also note that the user interests are determined in the same manner defined by the applicant’s specification by monitoring user inputs on a remote (see Schein at Column 12, Lines 27-30), and that a reminder can be set manually or automatically (see Schein at Column 12, Lines 24-27).

Referring to claim 93, Schein discloses automatically presenting the user with an opportunity to set a program reminder that is based on the user’s interests (Column 18, Lines 59-63 and Column 19, Lines 7-9). Note that the Program Info menu automatically pops up (Column 18, Lines 59-63) and then after the “Linked Services” option has been selected option 5 may be selected to set a reminder for the program being advertised (Column 19, Lines 7-9 and Figure 14A), all this is based on the which program the user is currently interested in (also see Figures 17A through 17F for presenting the user with an option to purchase an NFL cap for one of the teams participating in the football game).

Referring to claim 94, Schein discloses offering a pay-per-view event for purchase to the user that is based on the user’s interests (see movie on demand link leading to more pay-per-view options at Column 18, Lines 39-41, and an example of ordering one of the pay-per-view movies at Column 19, Lines 6-29 of Schein).

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Referring to claims 95-98, see rejection of claims 91-94.

Referring to claims 123-141, 143-157, and 159-163, see rejection of claims 1-19, 21-35, and 37-41, respectively.

Referring to claim 168-171, see rejection of claims 91-94, respectively.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20, 65 and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. in view of Official Notice.

Referring to claim 20, Schein discloses that a program has been viewed and that clock is present within the system (Column 6, Lines 61-62). Therefore, the examiner takes Official Notice that it is obvious to determine the amount of time a viewer is watching a program (using the clock) for the purpose of determining preferred viewing habits of a particular viewer.

Referring to claim 65, see rejection of claim 20.

Referring to claim 142, see rejection of claim 20.

5. Claims 36, 81 and 158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. in view of Schein et al. (U.S. Patent No. 6,323,911).

Referring to claim 36, Schein in the '714 patent discloses setting a reminder for a program (see Column 12, Lines 24-38), providing the user with an opportunity to request additional information related to the displayed targeted advertisement (see Column 18, Lines 12-25 and option (1) in Figure 17B). Schein in the '714 patent fails to specifically disclose displaying a targeted advertisement on top of the program for which the reminder was set. Schein teaches in the '911 patent that sets a reminder for the movie "Legends of the Fall" in Figure 10D, and then displaying an order menu with other targeted advertisements in Figure 11B (which is brought up after selecting the "Legends of the Fall" movie for which a reminder was set). At the time the invention was made, it would have been obvious to one skilled in the art to modify the interactive television system's EPG, as taught by Schein in the '714 patent, by adding the additional reminder menu feature to the exact same television system, as taught by Schein in the '911 patent, for the purpose of filtering through unwanted programming that the user may never view.

Referring to claim 81, see rejection of claim 36.

Referring to claim 158, see rejection of claim 36.

6. Claims 42-45, 87-90, and 164-167 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. in view of Klosterman et al. (U.S. Patent No. 6,078,348).

Referring to claim 42, Schein discloses all of the limitations in claim 1, as well as providing targeted advertisements. Schein fails to disclose that the targeted advertisement data contains attribute tags. Klosterman discloses that an advertisement database is created that provides advertising text and logos (attributes), including IDs for

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linking the ads to shows in the program guide (Column 4, Lines 45-49). Klosterman also discloses that the advertisement data structure is similar to the show list data structure, therefore refer to Figure 1F for examples of more attribute tags within a data structure. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the interactive television system, as taught by Schein, using the data structure hierarchy, which is transmitted to a user, as taught by Klosterman, for the purpose of allowing a user to access advertising information directly from the program guide (Column 4, Lines 48-49 of Klosterman).

Referring to claim 43, Schein discloses all of the limitations in claim 1, but fails to teach that the targeted advertising contains channel tags. Refer to the rejection of claim 42, and Figure 1E for an example of channel tags and proper motivation for combining Schein's invention with Klosterman's invention.

Referring to claim 44, Schein discloses all of the limitations in claim 1, but fails to teach that the targeted advertising contains time tags. Refer to the rejection of claim 42, and Figure 1F for an example of time tags and proper motivation for combining Schein's invention with Klosterman's invention.

Referring to claim 45, Schein discloses all of the limitations in claim 1, but fails to teach that the targeted advertising contains program tags. Refer to the rejection of claim 42, and Figure 1E for an example of program tags and proper motivation for combining Schein's invention with Klosterman's invention.

Referring to claims 87-90, see rejection of claims 42-45, respectively.

Referring to claims 164-167, see rejection of claims 42-45, respectively.

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7. Claims 99-102, 105-108, 111-114, and 117-120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. in view of Dedrick (U.S. Patent No. 5,724,521).

Referring to claim 99, Schein discloses monitoring a user's interactions with an interactive program guide to determine the user's interests and taking targeted actions in the program guide based on the user's interests (see rejection of claim 1). Schein fails to disclose monitoring which targeted action is taken in the program guide based on the user's interest and transmitting information on which targeted actions are taken to a central facility. Dedrick discloses that the end client system (user) is provided with a graphical user interface (see Column 3, Lines 29-31), that can request information (Column 3, Line 54-56), and that the metering server 14 (which provides only advertising content that is of interest to the user, see Column 14, Lines 25-29 for a demographic (user interest) server that collects user profile data sent to the metering server 14 from the end user) receives a request for electronic information, from the end user using the GUI (Column 15, Lines 54-62). Note that the metering server 14 acts as the central facility suggested by the applicant. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the interactive television system, as taught by Schein in Figure 10 showing multiple servers, by adding an additional metering server 14 to Schein's network, as taught by Dedrick, for the purpose of providing a system which allows electronic advertisers to target specific audiences, which they believe would be most receptive to their advertisements, and

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thus not require advertisers to provide an advertisement to the entire population (Column 1, Lines 52-58 of Dedrick).

Claim 100 corresponds to claim 99, with the additional limitation of the monitoring record containing information on which advertisements are displayed (Dedrick teaches this limitation at Column 7, Lines 1-15).

Claim 101 corresponds to claim 100, with the additional limitation of the monitoring record maintaining an advertisement identifier that identifies each targeted advertisement that is displayed in the monitoring record (Dedrick teaches this limitation at Column 11, Lines 59-64).

Claim 102 corresponds to claim 100, with the additional limitation of the monitoring record maintaining information on the date and time of the display of each targeted advertisement in the monitoring record (see end user providing an availability schedule within a calendar database at Column 16, Lines 51-60 of Dedrick).

Referring to claims 105-108, see rejection of claims 99-102, respectively.

Referring to claims 111-114, see rejection of claims 99-102, respectively.

Referring to claims 117-120, see rejection of claims 99-102, respectively.

Referring to claims 172-175, see rejection of claims 99-102, respectively.

Referring to claims 178-181, see rejection of claims 99-102, respectively.

***Allowable Subject Matter***

8. Claims 103-104, 109-110, 115-116, 121-122, 176-177, and 182-183 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Milnes et al. (U.S. Patent No. 6,118,492) discloses a program guide that is organized by channel, date and time.

Schein et al. (U.S. Patent No. 6,151,059) discloses another electronic programming guide with advertising.

Alexander et al. (U.S. Patent No. 6,177,931) discloses another electronic program guide with advertising.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-9048.



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